

**Remarks**

In view of the above amendments and the following remarks, favorable reconsideration of the outstanding office action is respectfully requested.

Claims 1-19 remain in this application. Claim 17 has been amended. Claims 20-31 have been canceled, without prejudice.

Applicants note with appreciation the Examiner's concern that the proper page 19 (claims 7-13) of the disclosure may not have been submitted to the Office. However, the page 19 received by the Office and reported to be attached to the last Office Action was not attached. Applicants request that the Examiner provide a copy of page 19 as received by the Office.

**1. Restriction Requirement**

The Examiner issued a Restriction Requirement identifying the following groups of claims as being drawn to potentially distinct inventions:

Group I. Claims 1-19 and 26-31, drawn to a method of forming soot for glass, classified in class 65, subclass 377;

Group II. Claims 20-25, drawn to an apparatus for forming soot, classified in class 65, subclass 484.

The Examiner asserted that these inventions may be regarded as independent and distinct from one another because the apparatus as claimed can be used to practice another process, such as one where there is no transition between liquids.

In a telephone conference with the undersigned agent of record dated May 28, 2003, a provisional election to Group I, claims 1-19 was made, with traverse. Applicants hereby confirm that provisional election, with traverse.

As a formality, Applicants hereby cancel claims 20-25, without prejudice.

Applicants respectfully traverse the Examiner's Restriction Requirement on the grounds that the proposed inventions are inextricably intertwined, and prosecution of the proposed groups of claims together would be most effective for the Office. In order to conduct a comprehensive search regarding any one of the groups, including the group provisionally elected above, it would be inherently necessary to review the same pertinent fields and classes of prior art relating to the other groups. Moreover, the important questions of patentability and claim interpretation are likely to be based on substantially similar issues and evaluations for each group of claims, and would require consideration of the same prior

art, and combined prosecution is therefore less likely to result in inconsistent or conflicting file histories.

As such, Applicant respectfully requests that the Examiner withdraw the Restriction Requirement in the next subsequent Office Action, and continue prosecution of Groups I-II, claims 1-25 together with one another.

Contingent upon the Examiner's decision not to withdraw the Restriction Requirement, Applicants have canceled claims 20-25, without prejudice.

## **2. Specification**

The Examiner has objected to the specification as lacking an Abstract. The abstract as originally filed is presented on a separate paper with the present Response.

## **3. Claim Objections**

The Examiner has objected to claims 17-19 under 37 CFR 1.75(c) as being of improper dependent form for failing to further limit the subject matter of a previous claim. Specifically, that claim 17 is directed to step d) in claim 1 when claim 1 has no step d). Applicants believe the enclosed amendments satisfy the requirements of 37 CFR 1.75(c).

## **4. Allowed Claims/Subject Matter**

Applicants note with appreciation the Examiner's allowance of claims 1-16 and 31. Applicants point out, however, that the Examiner has indicated that claim 31 is allowed under Allowable Subject Matter, and rejected under 35 U.S.C. §103. Applicants respectfully request that the Examiner clarify the status of claim 31.

## **5. § 112 Rejections**

The Examiner has rejected claims 26-31 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out or distinctly claim the subject matter which applicants regard as the invention. In particular, the Examiner asserts that claim 26, line 23 refers to a group of liquids consisting of a liquid reactant or a second liquid" and that this language is not understandable.

Applicants believe the enclosed amendments satisfy the requirements of 35 U.S.C. §112, second paragraph.

The Examiner has rejected claim 27 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement., specifically, that the claim contains subject matter not contained in the specification.

Applicants believe the enclosed amendments satisfy the requirements of 35 U.S.C. §112, first paragraph.

#### 6. § 103 Rejections

The Examiner has rejected claims 26-31 under 35 U.S.C. §103 as being unpatentable for obviousness over U.S. Patent No. 4,230,744 (Blankenship).

Applicants believe the enclosed amendments satisfy the requirements of 35 U.S.C. §103. Specifically, Applicants have cancelled claims 26-30, without prejudice.

#### 7. Conclusion

In view of the above. Applicants submit that the pending claims are in condition for allowance, and such allowance is earnestly solicited.

Applicants believe that no extension of time is necessary to make this Response timely. Should Applicants be in error. Applicants respectfully request that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Kevin M. Able at 607-974-2637.

Respectfully submitted,

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**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8:** I hereby certify that this paper and any papers referred to herein are being deposited with the U.S. Postal Service, as first class mail, postage prepaid, addressed to the Commissioner of Patents, Alexandria, VA 22313-1450 on 7/2/03.

  
Kevin M. Able, Signature